

## **REMARKS**

The Office Action dated November 14, 2008, has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. The following remarks are respectfully submitted to place the application in condition for allowance.

### **1. Status of Claims**

A detailed listing of all claims that are, or were present, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriately defined status identifier. Claims 1-12 are pending. Claims 1-10 and 12 are currently being examined, and claim 11 is withdrawn.

By this Amendment, Applicants have amended claims 1, 3, 5, 7, 9 and 12, and cancelled claims 2, 4, 6, 8 and 10. Support for the amendment to the claims can be found in the original claims and specification, *inter alia*, at page 3, lines 13-14 and the Examples. No new matter has been added by the amendments. Applicants respectfully request entry of the amended claims.

### **2. Claim Objections**

The Office objected to claim 9 due to a transcriptional error in the claim. By this Amendment, Applicants have amended claim 9 to recite “a skin cancer chemopreventive agent,” which corrects the claim recitation and clarifies the subject of the invention. Thus, Applicants request withdrawal of the claim objection.

### **3. Rejection under 35 U.S.C. § 112**

The Office rejected claims 2, 4, 6, 8, 10 and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting the limitation “The product” without an antecedent basis. By this Amendment, Applicants have cancelled claims 2, 4, 6, 8 and 10, thereby rendering the rejection of those claims moot. Applicants also amended claim 12 to recite the appropriate antecedent basis to the claim 9. Accordingly, amended claim 12 is definite and Applicants respectfully request withdrawal of the rejection.

**4. Rejection under 35 U.S.C. § 102/103**

The Office rejected claims 1-10 and 12 under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over Motoda (JP 57/206391), or Ganesan *et al.* (US Publication 2001/0033880), or Bouwens *et al.* (US Patent 5,879,730), or Goodsell *et al.* (US Patent 6,113,965), alleging that each reference teaches the process of making a black tea product that appears to be identical to the instantly claimed products since they are prepared by a similar process. The Office asserted that the products likely would inherently possess the same characteristics of the claimed products, thus the claimed invention would have been obvious.

Applicants disagree that the claimed invention is inherently anticipated or obvious over the cited art. By this amendment, Applicants have amended claims 1, 3, 5, 7, 9 and 12 to recite various agents produced by a process comprising the steps of selecting a first measure of green tea polyphenols; mixing said green tea polyphenols with a second measure of tyrosinase; and extracting at least once the mixture of said green tea polyphenols and tyrosinase after a period of oxidation reaction there between which produces theaflavins, but before the substantial formation of compounds other than theaflavins. There is no basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP 2112. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. For an inherency rejection to be proper, the prior art must necessarily produce the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

None of the cited references teaches extracting at least once a mixture of said green tea polyphenols and tyrosinase after a period of oxidation reaction there between which produces theaflavins, but before the substantial formation of compounds other than theaflavins. Motado teaches a pigment solution formed after enzyme treatment for 12 hours, which would not necessarily exclude formation of other compounds. Neither Ganesan *et al.* nor Bouwens *et al.* teach

extraction of the mixture of green tea polyphenols with tyrosinase to produce their black tea. Furthermore, Goodsell *et al.* teaches enzymatic fermentation with tannase only. Tannase is not tyrosinase. There is no technical basis to conclude that any of the processes in these cited references would produce the same product of the claimed invention to generate the same agents. Inherency may not be established by probabilities or possibilities. *Continental Can Co. v. Monsanto Co.*, 948 F. 2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991); *In re Rijckaert*, 9 F.3d at 1534 (Fed. Cir. 1993); *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999); *see also, Scaltech Inc. v. Retec/Tetra, L.L.C.*, 156 F.3d 1193, 51 USPQ2d 1055 (Fed. Cir. 1998). The mere fact that theaflavins of the claimed products may result from a method of extracting green tea is not sufficient to establish inherency. *Id.* In the absence of evidence that the theaflavins produced in the cited art necessarily would be the same as the claimed product, the Office's assertion that the instant invention is anticipated or obvious is incorrect. Applicants respectfully request withdrawal of the rejection.

## **5. Double Patenting**

The Office rejected claims 1-10 and 12 on the ground of nonstatutory obviousness-type double patenting over claims 1- 6 of U.S. Patent 6,602,527. Applicants concurrently submit a Terminal Disclaimer disclaiming the portion of the term of any patent which issues from the present application that extends beyond the term of U.S. Patent 6,602,527. Accordingly, the double patenting rejection is obviated and should be withdrawn.

## **6. CONCLUSION**

In view of the above amendment, Applicants believe the pending application is in condition for allowance and requests favorable action on the merits. Should the Examiner feel that any issues remain, Applicants request that the Examiner contact the undersigned so that the issues may be expeditiously addressed and prosecution of the instant application continue.

Applicants submit concurrently a request for a three-month extension of time under 37 C.F.R. § 1.136 and the accompanying fee. Please charge our Credit Card in the amount of \$555.00

covering the fees set forth in 37 C.F.R. § 1.17(a)(3). In the event that any additional extension of time is necessary to prevent the abandonment of this patent application, then such extension of time is petitioned. The U.S. Patent and Trademark Office is authorized to charge any additional fees that may be required in conjunction with this submission to Deposit Account Number 50-2228, referencing matter number 027141.0112C3US, from which the undersigned is authorized to draw.

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Respectfully submitted,

By 

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